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EXAMINER KARDOS, NEIL R				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patents@chadbourne.com

Office Action Summary

Application No.

10/632,392

Applicant(s)

MORAES ET AL.

Examiner

Neil R. Kardos

Art Unit

3623

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-268 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-268 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-912)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is a **NON-FINAL** Office Action on the merits in response to the request for continued examination filed on December 30, 2010. Currently, claims 1-268 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 30, 2010 has been entered.

Response to Arguments

Applicant's arguments filed on December 30, 2010 have been fully considered but they are not persuasive.

Applicant argues that the cited references (Paul and Brockenbrough) do not teach "providing by a processor an offer to compete by a first user, wherein the offer to compete includes parameters that specify a second user as a potential competitor and creative work evaluating competition rules." Examiner respectfully disagrees.

Brockenbrough discloses this limitation in item 606 of figure 6, which discloses the following invitation: "Hi Roger! Sam has invited you to play hangman"; the recipient of the invitation has the opportunity to accept it or decline it. This depiction teaches providing by a processor an offer to compete (an invitation to compete in a word game) by a first user (Sam),

wherein the offer to compete includes parameters that specify a second user (Roger) as a potential competitor and creative work evaluating competition rules (the game of hangman inherently includes competition rules; Roger has specified these rules by choosing to play hangman instead of, say, tic-tac-toe). Moreover, specifying the game of hangman constitutes "creative work evaluating competition rules" because hangman involves specific rules for evaluating player's words, letters, and guesses (i.e. their "creative works," which is a broad limitation). Thus, Brockenbrough teaches this limitation.

Furthermore, Paul discloses first and second users that compete (see paragraph 16, disclosing providing competitors with the opportunity to compete; paragraph 17, disclosing rap battle tournaments in which users face off; see also paragraph 12, disclosing user names). Paul also discloses creative work evaluating competition rules (see paragraph 8, disclosing competition rules and word limits placed on the length of a verse; paragraph 17, disclosing selecting a genre to compete in, as well as time limits and prizes for winners). Thus, Paul discloses first users, second users, and creative work evaluating competition rules. The only limitation missing from Paul is an invitation (the claimed "offer to compete"). Brockenbrough discloses such an invitation (see item 606 in figure 6). Thus, the cited references teach all of the claimed limitations. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the invitation of Brockenbrough to deliver the rules of Paul from a first user to a second user. One of ordinary skill in the art would have been motivated to do so for the benefit of allowing competitors to choose who they compete against.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 116-172, 242-247, and 254-268 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 116, 242, and 254: Claims 116, 242, and 254 are directed to a computer-readable medium. Given the broadest reasonable interpretation, these claims could be directed to transmission signals or carrier waves that are not eligible for patent protection. (See David J. Kappos, Subject Matter Eligibility of Computer Readable Media, 1351 OG 212 (February 23, 2010), available at <http://www.uspto.gov/web/offices/com/sol/og/2010/week08/TOC.htm#ref20>). Claims reciting transmission signals or carrier waves per se are not processes, machines, manufactures or compositions of matter; thus, they do not qualify as patent-eligible subject matter under § 101. See MPEP 2106; In re Nuijten, 500 F.3d 1346, 1357 (Fed. Cir. 2007).

This rejection can be overcome by amending the claims to recite a "non-transitory computer-readable medium."

Claims 117-172, 243-247, and 255-268: The dependent claims are rejected for failing to remedy the deficiencies of the claims from which they depend.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 58-115 and 236-241 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 58: Claim 58 recites limitations that begin with the phrase "means to." The claim does not use the term "means for" or "step for" which triggers a rebuttable presumption that 35 USC § 112, ¶ 6, does not apply. However, this presumption may be rebutted if the claim limitation uses a term that is not an art-recognized structure to perform the claimed function, the term is modified by functional language, and the term is not modified by sufficient structure or material for performing the claim function. See *Ex parte Rodriguez*, 92 USPQ2d 1395, 1404-1406 (Bd. Pat. App. & Int. 2009).

Here, the claim limitations begin with the phrase "means to" followed by functional language, and the phrase is not modified by sufficient structure or material for performing the claimed function. Accordingly, the limitation invokes 35 USC § 112, ¶ 6.

35 USC § 112, ¶ 6, requires such claim to be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. "If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section § 112." *In re Donaldson Co.*,

16 F.3d 1189, 1195, 29 USPQ 1845, 1850 (Fed. Cir. 1994)(in banc.). For a computer-implemented means-plus-function claim limitation that invokes 35 USC § 112, ¶ 6, **the corresponding structure is required to be more than simply a general purpose computer.** Aristocrat Technologies, Inc. v. International Game Technology, 521 F.3d 1328, 1333, 86 USPQ2d 1235, 1239-40 (Fed. Cir. 2008). The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer. WMS Gaming, Inc. v. International Game Technology, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999). The written description must at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the claimed function. Aristocrat, 521 F.3d at 1338, 86 USPQ2d at 1242.

In the instant application, it is not clear which portions of the specification and drawings describe the corresponding structure for performing the claimed functions. Furthermore, the written description does not include the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the claimed functions. Correction or clarification is required.

Claim 236: It is unclear whether the limitations in claim 236 are a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. The claims recites "means to" perform various functions. However, some of the "means to" phrases are modified by structure (a processor).

If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to:

(a) Amend the claim to include the phrase “means for” or “step for” in accordance with these guidelines: the phrase “means for” or “step for” must be modified by functional language and the phrase must **not** be modified by sufficient structure, material, or acts for performing the claimed function; or

(b) Show that the claim limitation is written as a function to be performed and the claim does **not** recite sufficient structure, material, or acts for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph. For more information, see MPEP § 2181.

Furthermore, it is not clear which portions of the specification and drawings describe the corresponding structure for performing the claimed functions. Furthermore, the written description does not include the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the claimed functions. Correction or clarification is required.

Claims 59-115 and 237-241: The dependent claims are rejected for failing to remedy the deficiencies of the claims from which they depend.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 12, 14-16, 19-27, 29-35, 39-41, 44-47, 58-67, 69, 71-73, 76-84, 86-93, 97-99, 102-105, 116-125, 127, 129-131, 134-142, 144-150, 154-156, 159-162, 173-182, 184, 186-188, 191-199, 201-207, 211-213, 267-219, 254-258, and 260-268 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul (US 2003/0171982) in view of Brockenbrough (US 2002/0065097).

Claim 1: Paul discloses a method of evaluating a creative work, comprising:

- providing via a processor an offer to compete by a first user (see paragraph 16, disclosing a web site that offers registrants the opportunity to compete);
- obtaining an acceptance to the offer to compete from the potential competitor (see paragraph 16, disclosing allowing registrants to choose whether or not to compete);
- pairing via the processor a plurality of competitors providing an indication evincing a desire to be evaluated (see paragraph 16, disclosing a series of one on one evaluations; paragraph 17, disclosing a tournament pairing format);
- obtaining a creative work from each paired competitor (see paragraph 17, disclosing allowing competitors to rap);

- providing the creative works from paired competitors for evaluation to an audience (see paragraph 16-17, disclosing observers);
- obtaining votes from members of the audience experiencing the creative works (see paragraph 17, disclosing voting);
- totaling via a processor votes for each creative work (see paragraph 17, disclosing counting votes with the winner advancing to compete further).

Paul does not explicitly disclose wherein the offer to compete includes parameters that specify a second user as a potential competitor and competition rules. Brockenbrough discloses this limitation (see figure 6: item 606, "Hi Roger! Sam has invited you to play hangman"; figure 2: item 24, disclosing presenting and accepting an invitation by a friend; figure 3: item 54: "Select friend to invite"; paragraphs 4, 20, 24, 25, 28, and 29, disclosing inviting a friend to play a selected game; paragraph 32, disclosing allowing the host to set rules). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include Brockenbrough's functionality of allowing competitors to specify a potential competitor and game rules when carrying out Paul's competition. One of ordinary skill in the art would have been motivated to do so for the benefit of enabling competitors to match up against their friends (see Brockenbrough: paragraph 4). One of ordinary skill in the art would have also been motivated to do so for the benefit of against competitors with a certain ranking in order to increase their own ranking (although not specifically relied upon in this rejection, see Jokipii, US 2003/0190960, paragraphs 46, 50, and 51).

Furthermore, Paul discloses first and second users that compete (see paragraph 16, disclosing providing competitors with the opportunity to compete; paragraph 17, disclosing rap

battle tournaments in which users face off; see also paragraph 12, disclosing user names). Paul also discloses creative work evaluating competition rules (see paragraph 8, disclosing competition rules and word limits placed on the length of a verse; paragraph 17, disclosing selecting a genre to compete in, as well as time limits and prizes for winners). Thus, Paul discloses first users, second users, and creative work evaluating competition rules. The only limitation missing from Paul is an invitation (the claimed "offer to compete"). Brockenbrough discloses such an invitation (see item 606 in figure 6). Thus, the cited references teach all of the claimed limitations. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the invitation of Brockenbrough to deliver the rules of Paul from a first user to a second user. One of ordinary skill in the art would have been motivated to do so for the benefit of allowing competitors to choose who they compete against (see Brockenbrough: paragraph 4).

Claim 2: Paul discloses wherein the evaluation is a tournament (see paragraph 17, disclosing a tournament format).

Claim 3: Paul discloses generating an offer to compete, prior to providing the offer to compete (see paragraph 16, disclosing a web site that offers registrants the opportunity to compete).

Claim 4: Paul discloses wherein the offer to compete is over creative works (see paragraphs 16-17, disclosing rap battles).

Claim 5: Paul does not explicitly disclose wherein the offer to compete is upon request of an offering competitor. Brockenbrough teaches this limitation (see figure 6: item 606, "Hi Roger! Sam has invited you to play hangman"; figure 2: item 24, disclosing presenting and accepting an invitation by a friend; figure 3: item 54: "Select friend to invite"; paragraphs 4, 20, 24, 25, 28, and 29, disclosing inviting a friend to play a selected game). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the requests taught by Brockenbrough when competitors desire to compete in the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. two competitors can choose to compete against one another).

Claim 6: Paul discloses selecting potential competitors for evaluation, prior to providing the offer to compete (see at least paragraph 6, disclosing that potential competitors must pay a membership fee in order to receive the offer to compete).

Claim 7: Paul discloses wherein selection for an evaluation is limited by qualification (see paragraph 6, disclosing that a potential competitor must pay a membership fee to qualify).

Claim 8: Paul discloses wherein the qualifications are for potential competitors (see id.).

Claim 9: Paul discloses wherein the qualifications are for creative works (see paragraph 8, disclosing that rap submissions are limited by word length and content).

Claim 10: Paul discloses wherein qualification is based on hand-selection (see paragraph 8, disclosing humans examining verses for compliance with rules).

Claim 12: Paul discloses wherein hand-selection is made by a division (see paragraph 6, disclosing dividing competition areas into sections according to age, sex, performance style, genre, etc.).

Claim 14: Paul discloses wherein qualifications are based on criteria stored in a database (see paragraph 7, disclosing storing registration information in a database).

Claim 15: Paul discloses wherein the criteria includes membership in a division (see paragraph 14, disclosing separate competition areas based on different languages, subject matter, age, sex, etc.; paragraph 18, disclosing inputting geographic information).

Paul does not explicitly disclose wherein this criteria is stored in a database. Examiner takes Official Notice that it was well-known in the computing arts at the time the invention was made to store information from a web site user in a database. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use well-known computing techniques to store the information disclosed by Paul (e.g. language, age, sex, location). One of ordinary skill in the art would have been motivated to do so for the benefit of efficiency gained by storing information (e.g. the information is only input once rather than every time the user accesses the system).

Claim 16: Paul discloses wherein membership in a division is based on geography (see paragraphs 14 and 18, discussed above).

Claim 19: Paul discloses wherein the criteria includes demographics (see paragraphs 14 and 18, discussed above). Paul does not explicitly disclose wherein this criteria is stored in a database. See claim 15 rejection for reasoning of why this would be obvious to one of ordinary skill in the art.

Claim 20: Paul discloses wherein selected competitors are paired at random (see paragraph 17, disclosing wherein a “stage” is open until it is filled).

Claim 21: Paul does not explicitly disclose wherein selected competitors are paired in a round-robin manner. However, Paul does disclose that persons may not be eliminated until they have lost two or even more one on one competitions (see paragraph 17). Examiner takes Official Notice that it is well-known in the competitive tournament arts to have competitors compete in a round-robin manner. For example, the format of the World Cup includes round-robin tournament play. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a round-robin format in the tournament disclosed by Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the tournament arts.

Claim 22: Paul does not explicitly disclose wherein selected competitors are paired through hand-selection. Brockenbrough teaches manual pairing of competitors (see figure 6: item 606, "Hi Roger! Sam has invited you to play hangman"; figure 2: item 24, disclosing presenting and accepting an invitation by a friend; figure 3: item 54: "Select friend to invite"; paragraphs 4, 20, 24, 25, 28, and 29, disclosing inviting a friend to play a selected game). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the manual pairing taught by Brockenbrough when pairing competitors in the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. manually paired competitors).

Claim 23: Paul does not explicitly disclose wherein selected competitors are paired through the issuance of an offer to compete and the acceptance of an offer to compete. Brockenbrough teaches this limitation (see figure 6: item 606, "Hi Roger! Sam has invited you to play hangman"; figure 2: item 24, disclosing presenting and accepting an invitation by a friend; figure 3: item 54: "Select friend to invite"; paragraphs 4, 20, 24, 25, 28, and 29, disclosing inviting a friend to play a selected game). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the offers taught by Brockenbrough when competitors desire to compete in the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. two competitors can choose to compete against one another).

Claim 24: Paul discloses wherein hand-selection is made by an audience (see paragraph 17, disclosing a tournament style competition where audience members vote on who will advance and thus choose which competitors will be paired).

Claim 25: Paul discloses wherein the offer to compete is provided to a plurality of potential competitors (see at least paragraph 16, disclosing a web site that offers registrants the opportunity to compete).

Claim 26: Paul discloses wherein the indication is an acceptance to an offer to compete (see paragraph 16, disclosing allowing registrants to choose whether or not to compete).

Claim 27: Paul does not explicitly disclose wherein the indication is an acceptance to an offer to compete. Brockenbrough teaches this limitation (see figure 6: item 606, "Hi Roger! Sam has invited you to play hangman"; figure 2: item 24, disclosing presenting and accepting an invitation by a friend; figure 3: item 54: "Select friend to invite"; paragraphs 4, 20, 24, 25, 28, and 29, disclosing inviting a friend to play a selected game). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the offers taught by Brockenbrough when competitors desire to compete in the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. two competitors can choose to compete against one another).

Claim 29: Paul discloses wherein paired competitors have a limited time in which to provide creative works (see at least paragraph 17, disclosing allowing competitors 30 seconds to spit their rap).

Claim 30: Paul discloses wherein paired competitors may employ feedback from audience members to update their creative work (see paragraph 17, disclosing allowing competitors to chat with viewers).

Claim 31: Paul discloses wherein competitors are to be paired at random (see paragraph 17, disclosing wherein a “stage” is open until it is filled).

Claim 32: Claim 32 is similar to claim 21 (above) and is rejected for similar reasons.

Claim 33: Claim 33 is substantially similar to claim 22 and is rejected for similar reasons.

Claim 34: Claim 34 is substantially similar to claim 23 and is rejected for similar reasons.

Claim 35: Paul discloses wherein audience members are limited by qualifications (see paragraphs 6 and 15, disclosing wherein observers must register and pay a membership fee).

Claim 39: Paul discloses wherein qualifications are based on criteria stored in a database (see paragraph 7, disclosing storing registration information in a database).

Claim 40: Claim 40 is similar to claim 15 except it relates to storing information regarding audience membership in a division rather than storing information related to competitor's membership in a division. Paragraphs 14 and 18 disclose criteria used for both participants and observers. Claim 40 is rejected for reasons similar to claim 15.

Claim 41: Claim 41 is similar to claim 16 and is rejected for similar reasons (see also claim 40 rejection, above).

Claim 44: Claim 44 is similar to claim 19 and is rejected for similar reasons (see also claim 40 rejection, above).

Claim 45: Paul discloses wherein the audience members provide feedback to paired competitors (see paragraph 17, disclosing observers chatting with competitors and voting on competitors' works).

Claim 46: Paul discloses wherein a winner is determined for an evaluation (see paragraph 17, disclosing tournament winners).

Claim 47: Paul discloses wherein a winner is provided to an audience (see paragraph 17, disclosing selecting winners to participate in live concerts).

Claim 254: Paul discloses a medium readable by a processor, comprising execution-instructions in the processor readable medium, wherein the execution-instructions are issuable by the processor to:

- access competition offer fields, of an offer by a first user, storing parameters that specify a second user as a potential competitor and creative work evaluating competition rules, wherein the competition offer field include (see paragraph 16, disclosing a web site that offers registrants the opportunity to compete and allows users to choose whether or not to compete; paragraph 8, disclosing competition rules and word limits placed on the length of a verse; paragraph 17, disclosing selecting a genre to compete in, as well as time limits and prizes for winners):
 - a competitor identifier field (see paragraphs 16-17, disclosing a field for a competitor's user name, a chat function allowing users to communicate and be identified by user name, and a voting function that allows a user to vote for a particular competitor);
 - a creative work format field, wherein the format field specifies a format type for evaluation of creative works (see paragraph 17, disclosing choosing a genre; paragraphs 8 and 10, disclosing text, audio, and video formats);

- a deadline field, wherein the deadline specifies a time allotment for submission of a creative work (see paragraph 17, disclosing a timer presenting the remaining time);
- a competitor type field, wherein competitor types include an individual and a crew (see paragraph 11, disclosing allowing multiple participants to intertwine their submissions);
- a competition mode field, wherein competition modes include regular and topical (see paragraphs 17 and 19, disclosing genres);
- a competition point value field (see paragraphs 16-17, disclosing voting on competitions);
- obtain an acceptance to the offer to compete from the potential competitor(see paragraph 16, disclosing allowing registrants to choose whether or not to compete);
- pair a plurality of competitors based on the acceptance to the offer according to parameters specified in the competition offer fields (see paragraph 16, disclosing a series of one on one evaluations; paragraph 17, disclosing a tournament pairing format).

Paul does not explicitly disclose a competition offer accepted field, a message field, and providing an offer to compete having the competition offer fields to the potential competitor. Brockenbrough discloses these limitations (see figure 6: item 606, "Hi Roger! Sam has invited you to play hangman"; figure 2: item 24, disclosing presenting and accepting an invitation by a friend; figure 3: item 54: "Select friend to invite"; paragraphs 4, 20, 24, 25, 28, and 29,

disclosing inviting a friend to play a selected game; paragraph 32, disclosing allowing the host to set rules). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include Brockenbrough's functionality of allowing competitors to specify a potential competitor and game rules when carrying out Paul's competition. One of ordinary skill in the art would have been motivated to do so for the benefit of enabling competitors to match up against their friends (see Brockenbrough; paragraph 4). One of ordinary skill in the art would have also been motivated to do so for the benefit of against competitors with a certain ranking in order to increase their own ranking (although not specifically relied upon in this rejection, see Jokipii, US 2003/0190960, paragraphs 46, 50, and 51). (Note: see also the rejection of claim 1 for further rationale to combine the references).

Furthermore, the claimed "fields" of data are merely non-functional descriptive data (such as printed matter or a mere arrangement of data). Such nonfunctional descriptive material is not given patentable weight absent a new and unobvious functional relationship between the nonfunctional matter and the substrate. In re Gulack, 703 F.2d 1381, 1385 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); MPEP 2106.01. Where the only difference between the prior art invention and the claimed invention is printed matter that is not functionally related to the functionality of the invention, the content of the printed matter will not distinguish the claimed product from the prior art. In re Ngai, 367 F.3d 1336, 1339 (Fed. Cir. 2004); MPEP 2112.01(III).

Claim 255: Paul discloses wherein the competitor identifier identifies a specific competitor (see paragraphs 16-17 as discussed above).

Claim 256: Paul discloses wherein the competitor identifier identifies criteria for selecting a potential competitor (see paragraphs 16-17 as discussed above; specifically the voting function).

Claim 257: Paul discloses wherein the criteria includes criteria saved in a database (see paragraph 7).

Claim 258: Paul discloses wherein the criteria includes divisions (see paragraphs 6 and 14, disclosing separate competition areas based on different languages, subject matter, age, sex, etc.; paragraph 18, disclosing inputting geographic information).

Claim 260: Paul discloses wherein the criteria includes divisions (see paragraphs 6, 14, and 18).

Claim 261: Paul discloses wherein the criteria includes geographic regions (see paragraphs 6, 14, and 18).

Claim 262: Paul discloses wherein the format type includes a duration for the creative work (see paragraph 17, disclosing a time).

Claim 263-267: Paul discloses wherein the format type includes multimedia, including audio, video, text, and graphics (see paragraphs 8 and 10, disclosing text, audio, and video).

Claim 268: Paul discloses wherein the format type includes a size limitation of the creative work (see paragraph 10, disclosing a size limitation).

Claims 58-60, 62-67, 69, 71-73, 76-84, 86-93, 97-99, 102-105, 116-125, 127, 129-131, 134-142, 144-150, 154-156, 159-162, 173-182, 184, 186-188, 191-199, 201-207, 211-213, and 216-219: These claims are substantially similar to the claims rejected above, except that they are directed to a system, apparatus, and computer readable medium for performing the method steps rejected above. Thus, they are rejected under similar rationale.

Claims 11, 13, 17-18, 28, 36-38, 42-43, 48-54, 68, 70, 74-75, 85, 94-96, 100-101, 106-108, 112, 126, 128, 132-133, 143, 151-153, 157-158, 163-165, 169, 183, 185, 189-190, 200, 208-210, 214-215, 220-222, 226, and 259 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul (US 2003/0171982) in view of Brockenbrough (US 2002/0065097), and further in view of Foroutan (US 7,162,433).

Claim 11: Paul does not explicitly disclose wherein hand-selection is made by an audience. Foroutan teaches using experts to review content submitted by potential contestants in order to decide which potential contestants are entered into the contest (see column 13: lines 2-15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use expert reviewers as taught by Foroutan to filter potential contestants for entry into

the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g., a pool of entrants selected by experts).

Claim 13: Paul does not explicitly disclose wherein qualification is random. Foroutan teaches randomly filtering contestants for entry into a creative works competition (see column 19; lines 57-66). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the random filtration taught by Foroutan when selecting contestants for entry into the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. a random pool of entrants).

Claim 17: Paul does not explicitly disclose wherein membership in a division is based on ranking. Foroutan teaches scoring and ranking creative works and selecting the top ranked works for entry into a contest (see column 24; line 42 through column 25; line 12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the scoring system taught by Foroutan to filter potential contestants for entry into the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. a pool of entrants consisting of the top-ranked works).

Claim 18: Paul does not explicitly disclose wherein criteria includes a ranking. This claim is substantially similar to claim 17 and is rejected for similar reasons.

Claim 28: Paul does not explicitly disclose wherein none of the paired competitors may view one another's creative works until the creative works are ready for evaluation by an audience. Foroutan teaches limiting access to creative works entered in the contest, including not allowing artists to view one another's works (see column 25; lines 32-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to limit access to creative works in a contest as taught by Foroutan when carrying out the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. artists cannot "cheat" or be placed in an advantageous position by viewing the works of others).

Claim 36: Paul does not explicitly disclose wherein qualification of audience members is based on hand-selection. Foroutan teaches pre-identifying, pre-registering, and pre-qualifying industry experts to review creative work submissions (see column 14; lines 4-7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to hand select qualified experts as taught by Foroutan to judge the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. audience members are experts in the field and thus have specialized knowledge that can be applied when judging the competition).

Claim 37: Paul does not explicitly disclose wherein audience member qualification is made by a division. Foroutan teaches selecting audience members who belong to a particular demographic or company (see column 14; lines 35-41). It would have been obvious to one of

ordinary skill in the art at the time the invention was made to employ the audience selection criteria of Foroutan when selecting individuals to view and judge the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. audience members of a particular demographic may be more interested in judging a particular competition).

Claim 38: Paul does not explicitly disclose wherein audience member qualification is random. Foroutan teaches randomly selecting an audience to review creative works (see column 21: lines 38-42; column 22: lines 18-23 and 58-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to randomly select audience members as taught by Foroutan when conducting the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. a random audience for viewing and judging).

Claim 42: Paul does not explicitly disclose wherein audience membership in a division is based on a ranking. Foroutan teaches different ranks for reviewers that determine whether or not they can vote in certain competitions (see column 31: lines 6-14 and column 31: line 64 through column 32: line 2, disclosing “Expert Reviewers” and “Super Reviewers”). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the audience ranking taught by Foroutan when selecting audience members to judge the competition of Paul. This combination of known elements produces a result that would be predictable to one

of ordinary skill in the art (e.g. the competitors can be judged by higher-ranked reviewers with more expertise).

Claim 43: Paul does not explicitly disclose wherein criteria includes a ranking. This claim is substantially similar to claim 42 and is rejected for similar reasons.

Claim 48: Paul does not explicitly disclose adjusting rankings based on voting results. Foroutan teaches ranking contestants and their works according to votes received by audience members (see column 32: lines 15-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust scores for the competitors in the competition of Paul using the scoring methods taught by Foroutan. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. ranking competitors based on votes received in order to determine a winner).

Claim 49: Claim 49 is substantially similar to claim 48 and is rejected for similar reasons.

Claim 50: Claim 50 is substantially similar to claim 48 and is rejected for similar reasons.

Claim 54: Paul does not explicitly disclose wherein rankings are also based on the format of the creative works. Foroutan teaches scoring competitors (see column 32: lines 15-61)

that compete in different creative works competitions (see column 11: lines 14-25; column 13: lines 60 through column 14: line 3; column 21: line 28 through column 23: line 28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to score different creative works competitions separately as taught by Foroutan when carrying out the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. creative works are compared to other creative works of the same type – comparing “apples to apples”).

Claim 259: Paul does not explicitly disclose wherein the criteria includes rankings. Foroutan teaches scoring and ranking creative works and selecting the top ranked works for entry into a contest (see column 24: line 42 through column 25: line 12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the scoring system taught by Foroutan to filter potential contestants for entry into the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. a pool of entrants consisting of the top-ranked works).

Claims 68, 70, 74-75, 85, 94-96, 100-101, 106-108, 112, 126, 128, 132-133, 143, 151-153, 157-158, 163-165, 169, 183, 185, 189-190, 200, 208-210, 214-215, 220-222, 226: These claims are substantially similar to the claims rejected above, except that they are directed to a system, apparatus, and computer readable medium for performing the method steps rejected above. Thus, they are rejected under similar rationale.

Claims 51-53, 109-111, 166-168, and 223-225 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul (US 2003/0171982), Brockenbrough (US 2002/0065097), and Foroutan (US 7,162,433), and further in view of Jokipii (US 2003/0190960).

Claim 51: Paul does not explicitly disclose wherein rankings take experience into account for a competitor. Jokipii teaches various ranking systems, including a "ladder system" that ranks players based on their total number of wins (see paragraphs 50-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a competitor's experience as taught by Jokipii into the ranking system of Foroutan when ranking competitors in Paul's competition. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. a ranking system that takes more than one round of competition into account).

Claim 52: Paul does not explicitly disclose wherein rankings are also based on competitors' current rankings. Jokipii teaches various ranking systems, including one that takes into account the current rankings of competitors when determining a new ranking (see paragraphs 50-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a competitor's current ranking as taught by Jokipii into the ranking system of Foroutan when ranking competitors in Paul's competition. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. a ranking system that rewards players for beating higher ranked opponents).

Claim 53: Claim 53 is substantially similar to claim 52, and is rejected under a similar rationale. However, claim 53 bases new rankings on the current ranking of a creative work, rather than the current ranking of a competitor. Because the combination of Foroutan and Paul teaches ranking creative works (see at least claim 50 rejection) and Jokipii teaches using current rankings to determine new rankings, claim 50 is merely a combination of known elements. In combination, these elements would perform the same function as they did separately, and one of ordinary skill would have recognized that the result of this combination is predictable.

Claims 109-111, 166-168, and 223-225: These claims are substantially similar to the claims rejected above, except that they are directed to a system, apparatus, and computer readable medium for performing the method steps rejected above. Thus, they are rejected under similar rationale.

Claims 55-57, 113-115, 170-172, and 227-229 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul (US 2003/0171982), Brockenbrough (US 2002/0065097), and Foroutan (US 7,162,433), and further in view of Von Kohorn (US 5,916,024).

Claims 55-57: Paul does not explicitly disclose the limitations of these claims. Von Kohorn discloses wherein rankings are also based on criteria stored in a database, wherein the criteria includes membership in a division, and wherein criteria includes demographics (see column 9: lines 9-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the stored demographic and divisional data of Van Kohorn into the ranking system of Foroutan when ranking competitors in Paul's competition.

This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. ranking North American competitors separately from European competitors).

Claims 113-115, 170-172, and 227-229: These claims are substantially similar to the claims rejected above, except that they are directed to a system, apparatus, and computer readable medium for performing the method steps rejected above. Thus, they are rejected under similar rationale.

Claims 230-253 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jokipii (US 2003/0190960) in view of Foroutan (US 7,162,433), and further in view of Paul (US 2003/0171982) and Brockenbrough (US 2002/0065097).

Claim 230: Jokipii discloses a method of reporting evaluations, comprising:

- updating via a processor rankings for competitors and creative works (see paragraphs 50-51);
- generating lists of competitors by criteria (see figure 7); and
- listing potential competitors by criteria (see figure 7).

Jokipii does not explicitly disclose wherein the rankings are based on evaluations by audience votes for creative works. Foroutan discloses these limitations (see at least column 32: lines 15-62). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Foroutan's ranking method when updating the rankings of Jokipii. This combination of known elements produces a result that would be predictable to one

of ordinary skill in the art (e.g. rankings for creative works are based on their appeal to an audience).

Furthermore, Jokipii does not explicitly disclose wherein each accepted offer to compete by a first user included parameters that specified a second user as a potential competitor and competition rules. However, Jokipii does suggest these limitations (see paragraph 35, disclosing allowing users to establish game settings; paragraph 46, disclosing permitting users to find players to engage in a game to initiate play; paragraphs 50-51, disclosing that players can select their potential competitor so that they can earn a certain rating by defeating an opponent with a higher ranking). Paul and Brockenbrough disclose these limitations (see sections cited in rejection of claim 1, above). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the functionality of Paul and Brockenbrough's to allow competitors to specify a potential competitor and game rules when carrying out Jokipii's competition. One of ordinary skill in the art would have been motivated to do so for the benefit of enabling competitors to match up against their friends (see Brockenbrough: paragraph 4). One of ordinary skill in the art would have also been motivated to do so for the benefit of against competitors with a certain ranking in order to increase their own ranking (see Jokipii, paragraphs 46, 50, and 51).

Claim 231: Jokipii discloses wherein the criteria is saved in a database (see paragraph 29).

Claim 232: Jokipii discloses wherein the criteria includes divisions (see figure 7, disclosing different rating divisions [2100+, 1800-2099, etc.]).

Claim 233: Jokipii discloses wherein the criteria includes rankings (see figure 7).

Claims 234-235: Jokipii does not explicitly disclose wherein the criteria includes demographics or geographic regions. Paul discloses inputting demographic and geographic information for a competitor (see paragraph 14, disclosing separate competition areas based on different languages, subject matter, age, sex, etc.; paragraph 18, disclosing inputting geographic information). Official Notice is taken that it was well-known in the arts at the time the invention was made to use various identifying criteria to filter individuals by geographic or demographic information. For example, this is often used in the advertising industry to target a particular market segment. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the input demographic and geographic disclosed by Paul to filter the lists of competitors disclosed by Jokipii according to well-known methods. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. a ranked list of competitors from North America or a ranked list of female competitors).

Claims 236-253: These claims are substantially similar to the claims rejected above, except that they are directed to a system, apparatus, and computer readable medium for performing the method steps rejected above. Thus, they are rejected under similar rationale.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. Kardos whose telephone number is (571)270-3443. The examiner can normally be reached on Monday through Friday from 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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